



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/313,436	05/17/1999	DAVID S. SPRINGER	M-7260US	3911

7590 02/21/2008  
DAVID L MCCOMBS  
HAYNES & BOONE LLP  
901 MAIN STREET  
SUITE 3100  
DALLAS, TX 75202-3789

EXAMINER
----------

LE, KHANH H

ART UNIT	PAPER NUMBER
----------	--------------

3622

MAIL DATE	DELIVERY MODE
-----------	---------------

02/21/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

1 UNITED STATES PATENT AND TRADEMARK OFFICE

2  
3  
4 BEFORE THE BOARD OF PATENT APPEALS  
5 AND INTERFERENCES  
6

7  
8 *Ex parte* DAVID S. SPRINGER and BRIAN T. ZUCKER  
9

10  
11 Appeal 2007-4207  
12 Application 09/313,436  
13 Technology Center 3600  
14

15  
16 Decided: February 21, 2008  
17

18  
19 Before JENNIFER D. BAHR, ANTON W. FETTING, and STEVEN D.A.  
20 McCARTHY, *Administrative Patent Judges*.  
21 FETTING, *Administrative Patent Judge*.

22 DECISION ON APPEAL

23 STATEMENT OF CASE

24 David S. Springer and Brian T. Zucker (Appellants) seek review under  
25 35 U.S.C. § 134 of a Final rejection of claims 1, 4-6, 8, 9, and 26-31, the only  
26 claims pending in the application on appeal.

27 We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

1     We AFFIRM.

2     The Appellants invented an advertising scheme that allows a computer user to  
3 benefit from viewing banner advertising by providing incentives for information  
4 transmitted to and from a computer server (Specification 2:12-15).

5     An understanding of the invention can be derived from a reading of exemplary  
6 claims 1, 8 and 26, which are reproduced below [bracketed matter and some  
7 paragraphing added].

8       1. A method of tracking information provided to a computer system  
9       from an advertisement database and a server accessed by a computer  
10      manufacturer, the method comprising:  
11      [1] providing an identifier unique to the computer system, the  
12      identifier being imbedded in one of the computer hardware and  
13      firmware in the computer system;  
14      [2] the database associating the identifier with information specific to  
15      a computer user associated with the computer system;  
16      [3] the computer user establishing a web connection with the server  
17      and transmitting the identifier to the database;  
18      [4] the user logging on to a combination advertisement broker server;  
19      [5] the computer system transmitting the identifier and requesting that  
20      a banner advertisement be displayed on the computer system;  
21      [6] the database checking for the identifier;  
22      [7] a counter accounting for the presence of the identifier; and  
23      [8] based on the number of times the database locates the identifier,  
24      the database:

- 1           determining which advertisements have been transmitted to the  
2           user; and  
3           based on the computer user associated with the identifier  
4           receiving a predetermined number of advertisements in a  
5           time period,  
6           the computer user associated with the identifier:  
7           receiving discounts on advertised computer  
8           components from the manufacturer.
- 9       8. The method of Claim 1 wherein the identifier is one of  
10       a system code,  
11       a system code stored in nonvolatile memory,  
12       a unique ID from a microprocessor,  
13       a unique ID from a peripheral device and  
14       a unique identifier stored on a hard drive.
- 15       26. A method for tracking information to a computer system from a  
16       server accessed by a computer manufacturer comprising:  
17       [1] providing an identifier unique to the computer system;  
18       [2] providing a database associating the identifier with information  
19       specific to a computer user;  
20       [3] the user logging on to a combination advertisement broker server;  
21       [4] the computer system transmitting the identifier and requesting that  
22       a banner advertisement be displayed on the computer system;  
23       [5] the database checking for the identifier;  
24       [6] a counter accounting for the presence of the identifier; and  
25       [7] based on the number of times the database locates the identifier,  
26       the database;  
27       determining which advertisements have been transmitted to the  
28       user; and

1 based on the computer user associated with the identifier  
2 receiving a predetermined number of advertisements in a time  
3 period,

4 the computer user associated with the identifier:

5 receiving discounts on advertised computer components  
6 from the manufacturer.

7 This appeal arises from the Examiner's Final Rejection, mailed July 20, 2005.

8 The Appellants filed an Appeal Brief in support of the appeal on April 27, 2006.

9 An Examiner's Answer to the Appeal Brief was mailed on July 17, 2006. A Reply  
10 Brief was filed on September 13, 2006.

11 PRIOR ART

12 The Examiner relies upon the following prior art:

Marsh	US 5,848,397	Dec. 8, 1998
Guyot	US 6,119,098	Sep. 12, 2000
Jenkins	US 6,285,983 B1	Sep. 4, 2001

13 REJECTIONS

14 Claims 1, 4, 5, 8, 9, 26-28, 30, and 31 stand rejected under 35 U.S.C. § 103(a)  
15 as unpatentable over Guyot and Jenkins.

16 Claims 6 and 29 stand rejected under 35 U.S.C. § 103(a) as unpatentable over  
17 Guyot, Jenkins, and Marsh.

18 ISSUES

19 The issues pertinent to this appeal are

- 1 • Whether the Appellants have sustained their burden of showing that the  
2 Examiner erred in rejecting claims 1, 4, 5, 8, 9, 26-28, 30, and 31 under 35  
3 U.S.C. § 103(a) as unpatentable over Guyot and Jenkins.
  - 4 • Whether the Appellants have sustained their burden of showing that the  
5 Examiner erred in rejecting claims 6 and 29 under 35 U.S.C. § 103(a) as  
6 unpatentable over Guyot, Jenkins, and Marsh.
- 7 The pertinent issues turn on whether the art describes or suggests using an  
8 identifier imbedded in one of the computer hardware and firmware in the computer  
9 system.

#### 10 FACTS PERTINENT TO THE ISSUES

11 The following enumerated Findings of Fact (FF) are believed to be supported  
12 by a preponderance of the evidence.

##### 13 *Facts Related to Claim Construction*

- 14 1. The disclosure contains no lexicographic definition of “imbed.”
- 15 2. The ordinary and customary meaning of “imbed” is to fix firmly, enclose  
16 snugly, or cause to be an integral part.<sup>1</sup>

##### 17 *Facts Related to Appellants’ Disclosure*

- 18 3. The Specification describes storing an identifier on a hard drive  
19 (Specification 5:15-18).

##### 20 *Guyot*

---

10<sup>1</sup> *American Heritage Dictionary of the English Language* (4<sup>th</sup> ed. 2000).

- 1       4. Guyot is directed to targeting and distributing advertisements over a  
2       distributed information network, such as the internet. Guyot provides a  
3       client application that runs on a subscriber's computer and a server that  
4       manages an advertisement database and that provides advertisements to  
5       the client application that are targeted to each individual subscriber,  
6       based on a personal profile provided by that subscriber (Guyot 1:56-65).
- 7       5. Guyot exchanges information between the server and the subscriber  
8       system, with the server and each of the subscriber systems having a  
9       unique identifier (Guyot 3:17-22).
- 10      6. Guyot's processor assigns credits to the subscriber based on the number  
11      of advertisements the subscriber has been exposed to. This information  
12      may then be used to provide remuneration to the subscriber based on the  
13      number of advertisements displayed on the subscriber system. A total  
14      credit amount indicator presents the number of credits the subscriber has  
15      earned over a predetermined period of time. The processor sends the  
16      total credit amount information to the server when a connection is  
17      established with the server (Guyot 6:6-16).
- 18      7. Guyot's Subscriber Statistics are valid for a predetermined period of  
19      time (Guyot 6:50-51).

20      *Jenkins*

- 21      8. Jenkins is directed to a marketing system for directing customized offers  
22      to consumers that includes a classes database derived from an

1 abstraction of the individual records database and second  
2 communications facilities that provide access by marketers to the  
3 marketing server (Jenkins 2:55-65).

4 9. Jenkins describes in background that data-driven marketing in general  
5 and direct marketing in particular have increasingly taken advantage of  
6 expanded electronic marketing, including, for example, offerings  
7 directed to individuals through e-mail accounts and the use of web  
8 browser cookie files to target web page banner ads. As is known in the  
9 art, cookie files<sup>2</sup> may be installed by a web site server on the computer  
10 hard disk drive of a browsing consumer.

11 *Facts Related To Differences Between The Claimed Subject Matter And The*  
12 *Prior Art*

13 10. One of ordinary skill knew that computer manufacturers advertised and  
14 promoted their products, including computer components.

15 11. One of ordinary skill knew that discounts were a widely used and  
16 predictable form of product promotion.

17 *Facts Related To The Level Of Skill In The Art*

18 12. Neither the Examiner nor the Appellants has addressed the level of  
19 ordinary skill in the pertinent arts of tracking items and data formatting.  
20 We will therefore consider the cited prior art as representative of the

---

15<sup>2</sup> As is well known, “[a] cookie is arbitrary data that a server provides to a browser  
16 in order to uniquely identify that user upon subsequent access to the server.”  
17 (Douglass, US 6,249,795 B1, Jun. 19, 2001, col. 2, ll. 8-10)



level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and a need for testimony is not shown’”) (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 807 F.2d 955, 963 (Fed. Cir. 1985)).

#### *Facts Related To Secondary Considerations*

13. There is no evidence on record of secondary considerations of non-obviousness for our consideration.

### PRINCIPLES OF LAW

#### *Claim Construction*

During examination of a patent application, pending claims are given their broadest reasonable construction consistent with the specification. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969); *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364, (Fed. Cir. 2004).

Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003) (claims must be interpreted “in view of the specification” without importing limitations from the specification into the claims unnecessarily)

Although a patent applicant is entitled to be his or her own lexicographer of patent claim terms, in *ex parte* prosecution it must be within limits. *In re Corr*, 2347 F.2d 578, 580 (CCPA 1965). The applicant must do so by placing such

1 definitions in the Specification with sufficient clarity to provide a person of  
 2 ordinary skill in the art with clear and precise notice of the meaning that is to be  
 3 construed. *See also In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (although  
 4 an inventor is free to define the specific terms used to describe the invention, this  
 5 must be done with reasonable clarity, deliberateness, and precision; where an  
 6 inventor chooses to give terms uncommon meanings, the inventor must set out any  
 7 uncommon definition in some manner within the patent disclosure so as to give  
 8 one of ordinary skill in the art notice of the change).

#### 9 *Obviousness*

10 A claimed invention is unpatentable if the differences between it and the  
 11 prior art are “such that the subject matter as a whole would have been obvious at  
 12 the time the invention was made to a person having ordinary skill in the art.”  
 13 35 U.S.C. § 103(a) (2000); *KSR Int’l v. Teleflex Inc.*, 127 S.Ct. 1727 (2007);  
 14 *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

15 In *Graham*, the Court held that that the obviousness analysis is bottomed on  
 16 several basic factual inquiries: “[ (1) ] the scope and content of the prior art are to be  
 17 determined; [ (2) ] differences between the prior art and the claims at issue are to be  
 18 ascertained; and [ (3) ] the level of ordinary skill in the pertinent art resolved.” 383  
 19 U.S. at 17. *See also KSR Int’l v. Teleflex Inc.*, 127 S.Ct. at 1734. “The  
 20 combination of familiar elements according to known methods is likely to be  
 21 obvious when it does no more than yield predictable results.” *KSR*, at 1739.

22 “When a work is available in one field of endeavor, design incentives and  
 23 other market forces can prompt variations of it, either in the same field or in a

1different one. If a person of ordinary skill in the art can implement a predictable  
2variation, § 103 likely bars its patentability.” *Id.* at 1740.

3 “For the same reason, if a technique has been used to improve one device,  
4and a person of ordinary skill in the art would recognize that it would improve  
5similar devices in the same way, using the technique is obvious unless its actual  
6application is beyond his or her skill.” *Id.*

7 “Under the correct analysis, any need or problem known in the field of  
8endeavor at the time of invention and addressed by the patent can provide a reason  
9for combining the elements in the manner claimed.” *Id.* at 1742.

## 10 ANALYSIS

11 *Claims 1, 4, 5, 8, 9, 26-28, 30, and 31 rejected under 35 U.S.C. § 103(a) as*  
12 *unpatentable over Guyot and Jenkins.*

13 The Appellants argue these claims as a group.

14 Accordingly, we select claim 26 as representative of the group.  
1537 C.F.R. § 41.37(c)(1)(vii) (2007).

16 The Examiner found that Guyot described all of the limitations of claim 26,  
17except those of having the party accessing the server be a computer manufacturer,  
18and having the discounts be associated with computer components from the  
19manufacturer. The Examiner implicitly found that such a computer manufacturer  
20would have been a predictable advertiser in Guyot’s system, and that discounts on  
21what the manufacturer sold would be predictable species of Guyot’s credits with  
22such an advertiser. The Examiner further found, as to the claims additionally

1 requiring an imbedded identifier as with claim 1, that Jenkins described an  
 2 example of an imbedded identifier as a cookie (Answer 3-6).

3 The Appellants contend that Jenkins' cookie does not contain an identifier  
 4 imbedded in a system hardware or software component during manufacture (Br.  
 5 11:Fourth ¶), and that Guyot does not describe a computer manufacturer and  
 6 discounts by such a manufacturer (Br. 11:Fifth ¶). The Appellants further argue  
 7 that neither Guyot nor Jenkins describes the desirability of the combination  
 8 because, in particular, cookies are undesirable in such a combination (Br. 12).

9 We disagree. As to whether either reference describes computer manufacturers  
 10 as advertisers or discounts on computer components, or suggests the desirability of  
 11 the combination of the references,

12 [t]he obviousness analysis cannot be confined by a formalistic  
 13 conception of the words teaching, suggestion, and motivation, or by  
 14 overemphasis on the importance of published articles and the explicit  
 15 content of issued patents. The diversity of inventive pursuits and of  
 16 modern technology counsels against limiting the analysis in this way.  
 17 In many fields it may be that there is little discussion of obvious  
 18 techniques or combinations, and it often may be the case that market  
 19 demand, rather than scientific literature, will drive design trends.

20 *KSR*, 127 S. Ct. at 1741. Further,

21 When a work is available in one field of endeavor, design incentives  
 22 and other market forces can prompt variations of it, either in the same  
 23 field or a different one. If a person of ordinary skill can implement a  
 24 predictable variation, § 103 likely bars its patentability.

25 *id.* at 1740. Guyot distributes advertisements using a client application that  
 26 runs on a subscriber's computer and a server that manages an advertisement

1 database and that provides advertisements to the client application that are targeted  
2 to each individual subscriber, based on a personal profile provided by that  
3 subscriber (FF ). As pointed out by the Examiner (Answer 5), a computer  
4 manufacturer is a predictable embodiment of Guyot's advertiser, whose advertising  
5 would be driven by market forces.

6 Guyot assigns credits to its subscriber based on the number of advertisements  
7 the subscriber has been exposed to. This information may then be used to provide  
8 remuneration to the subscriber based on the number of advertisements displayed on  
9 the subscriber system. A total credit amount indicator presents the number of  
10 credits the subscriber has earned over a predetermined period of time (FF ). We  
11 find that discounts are a predictable embodiment of Guyot's remuneration since a  
12 discount is a widely practiced form of promotion, again driven by market forces.  
13 We further find that such discounts would likely pertain to items or services sold  
14 by the discounter for the simple reason that discounts are with respect to sales,  
15 which in the case of a computer manufacturer would include computer  
16 components.

17 The remaining arguments by the Appellants regarding the limitation of  
18 imbedding an identifier are moot with respect to claim 26, because claim 26 is a  
19 method claim and contains no structural limitation regarding the imbedding of an  
20 identifier. Thus, the Appellant has not sustained its burden of showing that the  
21 Examiner erred in rejecting claims 26-28, 30, and 31.

22 Although the Appellants argued the claims as a group and we have found the  
23 Appellants have not sustained their burden as to representative claim 26, we will

1address the Appellants’ arguments in support of claim 1. To do so, we must next  
2construe the limitation “identifier being imbedded in one of the computer hardware  
3and firmware in the computer system.” The word “imbed” is not lexicographically  
4defined by the disclosure. The common meaning of the verb “imbed” within the  
5context of an item of data such as an identifier is “to fix firmly” (FF & ).  
6Therefore we construe the limitation of “identifier being imbedded in one of the  
7computer hardware and firmware in the computer system” as “identifier being  
8fixed firmly in one of the computer hardware and firmware in the computer  
9system.”

10 Guyot describes relying on a unique identifier (FF ). Jenkins describes one  
11technique for providing such an identifier, a cookie, as a data element stored on a  
12hard drive (FF ). Thus the issue becomes whether storing an identifier as a cookie  
13on a hard drive provides an identifier fixed firmly in one of the computer hardware  
14and firmware in the computer system. We find that the Appellants’ disclosure  
15describes storing an identifier on a hard drive (FF ) and that claim 8, which  
16depends from claim 1, embraces an embodiment including an identifier stored on a  
17hard drive. Thus, the Appellants’ disclosure supports construing the scope of  
18claim 1 to include identifiers stored on a hard drive and claim 8 requires that the  
19scope of claim 1 be broad enough to encompass an identifier stored on a hard  
20drive.

21 We now turn to the Appellants’ argument that cookies present well known  
22problems, *viz.* cookies do not automatically identify the client computer's owner to  
23enable advertising revenue sharing; do not automatically allow any correlation

1between the computer's owner and his individual preferences for targeted  
2advertising; and are lacking in desirable security features because they can be  
3easily altered, deleted, disabled or copied to multiple computers (Br. 12). We find  
4that whether such problems exist is moot because claim 1 does not require  
5identifying the computer's owner, or a correlation between the computer's owner  
6and the owner's preferences, or any security features.

7 The Appellants have not sustained their burden of showing that the Examiner  
8erred in rejecting claims 1, 4, 5, 8, 9, 26-28, 30, and 31 under 35 U.S.C. § 103(a) as  
9unpatentable over Guyot and Jenkins.

10 *Claims 6 and 29 rejected under 35 U.S.C. § 103(a) as unpatentable over Guyot,*  
11 *Jenkins, and Marsh.*

12 The Appellants have relied upon the arguments for the patentability of claim 1,  
13*supra*, which we found to be insufficient to meet the Appellants' burden.  
14Therefore, the Appellants have not sustained their burden of showing that the  
15Examiner erred in rejecting claims 6 and 29 under 35 U.S.C. § 103(a) as  
16unpatentable over Guyot, Jenkins, and Marsh.

17 CONCLUSIONS OF LAW

18 The Appellants have not sustained their burden of showing that the Examiner  
19erred in rejecting claims 1, 4-6, 8, 9, and 26-31 under 35 U.S.C. § 103(a) as  
20unpatentable over the prior art.

## DECISION

To summarize, our decision is as follows:

- The rejection of claims 1, 4, 5, 8, 9, 26-28, 30, and 31 under 35 U.S.C. § 103(a) as unpatentable over Guyot and Jenkins is sustained.
- The rejection of claims 6 and 29 under 35 U.S.C. § 103(a) as unpatentable over Guyot, Jenkins, and Marsh is sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

JRG

17

DAVID L. MCCOMBS  
HAYNES & BOONE LLP  
20901 MAIN STREET  
SUITE 3100  
DALLAS, TX 75202-3789